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EXAMINER

NGUYEN, TAN D

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/863,476	Applicant(s) SHINKAI, YASUHIRO	
	Examiner Tan Dean D. Nguyen	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the decision on the pre-Appeal conference of 3/30/09, the following actions are taken.

Claim Status

2. Claims 1-13, 15-24 are pending. Claim 14 has been canceled. They comprise of 5 groups:

- 1) system: 1-5, 16-20,
- 2) system: 6-9, 12, 15, and 21,
- 3) method: 10-22,
- 4) method: 11, 13 and 23, and
- 5) system: 24.

As of 7/17/2008, independent system claim 1 is as followed:

1. (currently amended): A print order acceptance system for accepting an order for printing images on the basis of digital image data, wherein the system comprises:

a) an order acceptance ~~machine which~~ accepts means for accepting digital image data and order information and ~~transfers~~ for transferring the image data and the order information to an image printer; and

b) a voucher printer which is separate from the image printer and which prints a voucher including thumbnail images as high resolution data and details of an order on the basis of the order information, the thumbnail images corresponding to image data which have been accepted by the order acceptance ~~machine~~ means and have been transferred to the image printer.

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Note: for convenience, letters (a) and (b) are added to label each element above.

3. Note: claim 1 is an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

1) This is an apparatus claim and intended use limitation for the system/device or apparatus, i.e. “for transferring the image data and the order information to an image printer” in element (a) carries no patentable weight.

2) Also, in element (b), the phrase “which prints a voucher including thumbnail images as high resolution data and details of an order on the basis of the order information, the thumbnail images corresponding to image data which have been accepted by the order acceptance ~~machine~~-means and have been transferred to the image printer” is reciting like a method step and is considered as manner of operating the voucher printer and thus having no patentable weight as indicated above.

3) Similarly, in claim 6, which has similar limitation in (a), it's interpreted for the same reason set forth in item (1) above.

4) Similarly, in claim 6, element (b), the phrase "which transmitsto the image printer", which has similar similar issue as item (2) of claim 1, it's interpreted for the same reason set forth in item (2) above.

5) Similarly, in claim 24, which has similar limitation in (a), it's interpreted for the same reason set forth in item (1) above.

6) Similarly, in claim 6, element (b), the phrase "which prints a voucher ... to the image printer", which has similar issue as item (2) of claim 1, it's interpreted for the same reason set forth in item (2) above.

Independent method claim 10 is as below:

10. (previously presented): A print order acceptance method for accepting an order for printing images on the basis of digital image data, wherein the method comprises the steps of:

- a) transferring to an image printer ordered image data and order information; and
- b) instructing a voucher printer, which is separate from the image printer, to print a voucher including thumbnail images prepared on the basis of high-precision image data and details of the order on the basis of the order information, the thumbnail images corresponding to image data which have been transferred to the image printer.

Note: In claim 1, step (b), the phrase "to print a voucher including thumbnail images prepared on the basis of high-precision image data and details of the order on

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the basis of the order information, the thumbnail images corresponding to image data which have been transferred to the image printer" is not a positively recited method step but, rather, is mere intended use of the instructed printer and thus having no patentable weight. See MPEP 2173.05 (q), 2106, and 2111.04, which indicate that a method claim requires active, positive steps. If a printing step is required in step (b), then there should be another step calling for "printing a voucher including....".

Similarly, in claim 11, the phrase "...prepared on the basis ... and the order information" is not a positively recited method step.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 1-5, 16-20 (system), 6-9, 12, 15 and 21 (system), and 24 (system) are rejected under 35 U.S.C. 101 because the claimed invention is directed to more than one class of statutory subject matter.**

The independent claim 1 begin by discussing a print order acceptance system (apparatus) but the body of each claim containing method steps, i.e. "which prints", "have been accepted", "have been transferred", etc., discusses the steps. "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only". See Ex parte Lyell (17 USPQ2d 1548).

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Similarly, claims 4, 5, 6, 7, 8, 9, 12, 15, 16, 17, 18, 19, 20, 21, and 24, which are supposed to be apparatus claims, however, they contain method steps, and are rejected for the same reason set forth in the rejection of claim 1 above.

6. Claims 10, 22 (method) and 11, 13 and 23 (method) are rejected under 35 U.S.C. 101.

7. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to an examiner is that a § 101 process must (1) be tied to a particular machine or apparatus or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

To qualify as a § 101 statutory process, the claim should recite the particular machine or apparatus to which it is tied, for example by identifying the machine or apparatus that accomplishes the method steps, or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a

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specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

Here, applicant's method steps fail the first prong of the new test because the claimed invention fails to set forth a particular machine that is specifically configured or programmed to carry out the claimed invention. Specifically, the Examiner asserts that the current claim language can be interpreted that the user, is performing the claimed invention.

Further, applicant's method steps fail the second prong of the test because there is no transformation of the data. It is asserted that the data has not been transformed into another state or into another object.

Claim 10 contains 2 positive method steps recitations: transferring data and then instructing a voucher printer. Note that "to print" is intended use as indicated above.

Claim 11 contains 2 positive method steps recitations: transferring data and then transmitting images.

The applicant is reminded that:

"Purported transformation or manipulations simply of public or private legal obligations or relationships, business risks, or other such abstractions cannot meet the test because they are not physical objects or substances, and they are not representative of physical objects or substances.

Moreover, the "transformation must be central to the purpose of the claimed process.

(In re Bernard L. Bilski and Rand A. Warsaw Page 28)"

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-5, 16-20, 6-9, 12, 15, 21 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim elements “means for accepting the digital image data”, “means for transferring the image data”, and “means for displaying images”, “transmission means”, is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. Pages 3-4 have been reviewed but the examiner does not find disclose the corresponding structure, material, or acts for the claimed functions.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

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(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

11. Claim element elements “means for accepting the digital image data”, “means for transferring the image data”, and “means for displaying images”, “transmission means”, is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. Pages 3-4 have been reviewed but the examiner does not find disclose the corresponding structure, material, or acts for the claimed functions.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or

(c) State on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

12. Claims 1-5, 16-20 (system), 10, 22 (method), 6-9, 12, 15, 21 (system) and 11, 13, 23 (method) and 24 (system) are rejected under 35 U.S.C. 103(a) as being unpatentable over WINTER et al alone or further in view of SEVCIK et al.

Similarly, **WINTER et al** discloses a print order acceptance system/method for accepting an order for printing images on the basis of digital image data, comprising elements/steps of:

a) an order acceptance machine which accepts digital image data and order information and transfers the image data and the order information to an image printer (first printer); and

{see Fig. 1, Fig. 7, }

b) another printer to generate a combination of the customer proof sheet and order form 58 (Fig. 4) for that particular thumbnail image on a single sheet of paper when the user filling in the bubble next to "Cstm" which causes the ink jet printer 14 to generate a combination above.

{see Fig. 3A, Fig. 4, col. 4, lines 30-60, col. 5, lines 50-60}.

As for the limitation that the printer in (b) is separate from the printer (a), WINTER et al discloses the uses of various printers for performing the desired output on col. 3, lines 60-67, "laser printer, inkjet printer, dot matrix printer, thermal printer, etc. to produce a suitable quality image...", and the difference pixels required for thumbnail images vs. final print in cols. 5-7, it would have been obvious to use a separate printer in element (b) to reduce cost or for convenience so that the two functions can be carried out at the same time instead of waiting for the other job if desired. Also, the teaching of "To make separable" a function or device is well known legal precedent and it would have been obvious to separate the printer into 2 separate printers for convenience if desired. Note that this limitation in step (b) of claim "which prints" is considered as "capable of" in an apparatus claim and the printer in WINTER et al is capable of carrying out this "printing" function or would have been obvious to do so if desired.

Alternatively, in a similar printing job, **SEVCIK et al** is cited to teach the concept of confirming a job after customer order wherein the confirming order including details of the orders such as the printing selections and ordered information and billing information and displaying the "confirming job" information to the customer prior to carrying out the job to inherently obtain the well known benefits of eliminating wastes due to carrying out the job using wrong information or not customer desired job or information {see Fig. 7, right hand picture, "Are you sure you wish to begin this job"}.

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It would have been obvious modify the teachings of WINTER et al by modifying the ordering feature to include a confirming feature prior to carrying out the printing job as taught by SEVCIK et al above to obtain the inherent benefit of eliminating waste due to wrong order and wherein the confirmation is a combination of proof sheet which include ordered thumbnail images and order form contains other relevant information such as ordered information as taught by WINTER et al when the printing job includes images.

As for dep. claim 2 (part of 1), which deals with the intended use of the voucher, i.e. ascertaining printouts of images, this carries no patentable weight in an apparatus claim which only gives patentable weight to system structural elements or structures. Moreover, this is also taught in SEVCIK et al Fig. 7.

As for dep. claim 3 (part of 1), which deals with other elements of the print order acceptance system, i.e. means for displaying images, this is shown in Fig. 3A, 4, or 6A of WINTER et al or Figs. 7-8 of SEVCIK et al.

As for dep. claims 4, 5 (part of 1), which deals with the type of images received and/or produced, i.e. thumbnail images, these are fairly taught in Figs. 3A or 4 or 6A of WINTER et al.

As for dep. claim 16 (part of 1), which further limits the deals with the feature of the thumbnail images, this has no structural elements and does not further limit the printer or acceptance machine of claim 1, resulting in on patentable weight. Moreover, this is taught in WINTER et al Fig. 3A, and 6A.

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As for dep. claims 17-18, 19-20 (part of 1), which deal with how the voucher printer operates, these are inherently included in the teachings of WINTER et al and/or WINTER et al /SEVCIK et al. Furthermore, they have no structural elements and does not further limit the printer or acceptance machine of claim 1, resulting in on patentable weight. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Apparatus claims cover what a device is, not what a device does. Manner of operating the device does not differentiate apparatus claim from the prior art. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Circuit 1997). Ex Parte Masham, 2 USPQ2d 1647.

As for independent method¹ claim 10, which is the respective method of the system claim 1 above, it's rejected over the steps to carry out the system of WINTER et al or WINTER et al /SEVCIK et al as shown in the rejection of claim 1 above.

As for dep. claim 22, which is not positively cited but is passively recited, it's interpreted as being capable of, and the data and order information of WINTER et al or WINTER et al /SEVCIK is capable of this feature.

As for independent system claim 6, which has similar limitation as in independent system claim 1, part (a) and wherein part (b) has an electronic mail transmission means which transmits the combination of proof sheet and order information to the order user, the teaching of electronic mail transmission means for

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transmitting digital images and information is taught in WINTER et al, col. 1, lines 25-30, col. 6, lines 10-60, and col. 8, lines 25-55. Also, this is taught in Fig. 1A, col. 1.

As for dep. claims 7, 8, 9 (part of 6 above), these are fairly taught in WINTER et al Figs. 3A, 4, 6A, or SEVCIK et al Figs. 1, 18.

As for dep. 12 (part of 6), which has similar limitations as in dep. 13 above, it's rejected for the same reasons set forth in dep. claim 13 above.

As for dep. 15 (part of 6), the use of other well known Internet network communication devices, such as cellular phone, for use with the system above would have been obvious to a skilled artisan as mere using other well known communication devices such as portable for convenience or portable communication.

As for dep. claim 21 (part of 6), which deal with how the voucher printer operates, these are inherently included in the teachings of WINTER et al and/or WINTER et al /SEVCIK et al. Furthermore, they have no structural elements and does not further limit the printer or acceptance machine of claim 1, resulting in on patentable weight. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Apparatus claims cover what a device is, not what a device does. Manner of operating the device does not differentiate apparatus claim from the prior art. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Circuit 1997). Ex Parte Masham, 2 USPQ2d 1647.

As for independent method² claims 11, which is the respective method of the system claim 6 above, it's rejected over the steps to carry out the system of WINTER et al or WINTER et al /SEVCIK et al as shown in the rejection of claim 1 above.

As for dep. claim 13 (part of 11), which deals with well known email parameter, this is inherently including in the email communication of WINTER et al.

As for dep. claim 23 (part of 11), which is not positively cited but is passively recited, it's interpreted as being capable of, and the data and order information of WINTER et al or WINTER et al /SEVCIK is capable of this feature.

As for independent system³ claim 24, which has similar limitation as in independent system claim 1, part (a) and wherein part (b) has an electronic mail transmission means which transmits the combination of proof sheet and order information to the order user, the teaching of electronic mail transmission means for transmitting digital images and information is taught in WINTER et al, col. 1, lines 25-30, col. 6, lines 10-60, and col. 8, lines 25-55. Also, this is taught in Fig. 1A, col. 1.

Note above, item (5) Similarly, in claim 24, which has similar limitation in (a), it's interpreted for the same reason set forth in item (1) above.

6) Similarly, in claim 6, element (b), the phrase "which prints a voucher ... to the image printer", which has similar issue as item (2) of claim 1, it's interpreted for the same reason set forth in item (2) above.

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13. Claims 1-5, 16-20 (system), 10, 22 (method), 6-9, 12, 15, 21 (system) and 11, 13, 23 (method) and 24 (system) are rejected (2nd time) under 35 U.S.C. 103(a) as being unpatentable over TAMURA et al in view of WINTER et al or vice versa.

Similarly, TAMURA et al discloses a print order acceptance system/method for accepting an order for printing images on the basis of digital image data, comprising elements/steps of:

a) an order acceptance machine which accepts digital image data and order information and transfers the image data and the order information to an image printer (first printer); and

{see Fig. 4, elements 100, 211, 212}

b) another receipt/voucher device which is separate from the image printer which prints a receipt and handled to the user when an order is received from the user.

{see Fig. 4, element 212", col. 9, lines 25-35"}.

TAMURA et al does not disclose the receipt/voucher including thumbnail images and detailed order information.

Similarly, **WINTER et al** discloses a print order acceptance system/method for accepting an order for printing images on the basis of digital image data, comprising elements/steps of:

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a) an order acceptance machine which accepts digital image data and order information and transfers the image data and the order information to an image printer; and

{see Fig. 1, Fig. 7, }

b) generate a combination of the customer proof sheet and order form 58 (Fig. 4) for that particular thumbnail image on a single sheet of paper when the user filling in the bubble next to "Cstm" which causes the printer to generate a combination above, thus enabling a user to **easily select** and **print digitally stored images** {see col. 1, lines 10-20, col. 2, lines 15-67, col. 4, lines 30-60, col. 5, lines 50-60, Figs. 3A and 3B}.

It would have been obvious to a skilled artisan to replace to voucher printing with the combination of the customer proof sheet and order form 58 (Fig. 4) for that particular thumbnail image on a single sheet of paper when the user filling in the bubble next to "Cstm" which causes the printer to generate a combination above as taught by WINTER et al for the benefit of enabling a user to **easily select** and **print digitally stored images** {see col. 1, lines 10-20, col. 2, lines 15-67, col. 4, lines 30-60, col. 5, lines 50-60, Figs. 3A and 3B}.

Alternatively, it would have been obvious to modify the teachings of WINTER et al by using two separating printing devices as taught by TAMURA et al for inherently convenience instead of switching back and forth the printer.

As for dep. claim 2 (part of 1), which deals with the intended use of the voucher, i.e. ascertaining printouts of images, this carries no patentable weight in an apparatus

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claim which only gives patentable weight to system structural elements or structures.

Moreover, this is also taught in TAMURA et al Fig. 4.

As for dep. claim 3 (part of 1), which deals with other elements of the print order acceptance system, i.e. means for displaying images, this is shown in Fig. 3A, 4, or 6A of WINTER et al or Figs. 5A-5B, 13 of TAMURA et al.

As for dep. claims 4, 5 (part of 1), which deals with the type of images received and/or produced, i.e. thumbnail images, these are fairly taught in Figs. 3A or 4 or 6A of WINTER et al or TAMURA et al Figs. 4, Figs. 5A-5B, 13.

As for dep. claim 16 (part of 1), which further limits the deals with the feature of the thumbnail images, this has no structural elements and does not further limit the printer or acceptance machine of claim 1, resulting in on patentable weight. Moreover, this is taught in WINTER et al Fig. 3A, and 6A.

As for dep. claims 17-18, 19-20 (part of 1), which deal with how the voucher printer operates, these are inherently included in the teachings of WINTER et al and/or WINTER et al /TAMURA et al. Furthermore, they have no structural elements and does not further limit the printer or acceptance machine of claim 1, resulting in on patentable weight. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Apparatus claims cover what a device is, not what a device does. Manner of operating the device does not differentiate apparatus claim from the prior art. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Circuit 1997). Ex Parte Masham, 2 USPQ2d 1647.

As for independent method¹ claim 10, which is the respective method of the system claim 1 above, it's rejected over the steps to carry out the system of TAMURA et al /WINTER et al as shown in the rejection of claim 1 above.

As for dep. claim 22, which is not positively cited but is passively recited, it's interpreted as being capable of, and the data and order information of TAMURA et al/WINTER et al al is capable of this feature.

As for independent system claim 6, which has similar limitation as in independent system claim 1, part (a) and wherein part (b) has an electronic mail transmission means which transmits the combination of proof sheet and order information to the order user, the teaching of electronic mail transmission means for transmitting digital images and information is taught in TAMURA et al/WINTER et al, as shown in WINTER et al col. 1, lines 25-30, col. 6, lines 10-60, and col. 8, lines 25-55. Also, this is taught in Fig. 1A, col. 1.

As for dep. claims 7, 8, 9 (part of 6 above), these are fairly taught in WINTER et al Figs. 3A, 4, 6A, or TAMURA et al Figs. 5A-5B, 13.

As for dep. 12 (part of 6), which has similar limitations as in dep. 13 above, it's rejected for the same reasons set forth in dep. claim 13 above.

As for dep. 15 (part of 6), the use of other well known Internet network communication devices, such as cellular phone, for use with the system above would have been obvious to a skilled artisan as mere using other well known communication devices such as portable for convenience or portable communication.

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As for dep. claim 21 (part of 6), which deal with how the voucher printer operates, these are inherently included in the teachings of TAMURA et al/WINTER et al. Furthermore, they have no structural elements and does not further limit the printer or acceptance machine of claim 1, resulting in on patentable weight. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Apparatus claims cover what a device is, not what a device does. Manner of operating the device does not differentiate apparatus claim from the prior art. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Circuit 1997). Ex Parte Masham, 2 USPQ2d 1647.

As for independent method² claims 11, which is the respective method of the system claim 6 above, it's rejected over the steps to carry out the system of TAMURA et al/WINTER et al or vice versa et al as shown in the rejection of claim 1 above.

As for dep. claim 13 (part of 11), which deals with well known email parameter, this is inherently including in the email communication of WINTER et al.

As for dep. claim 23 (part of 11), which is not positively cited but is passively recited, it's interpreted as being capable of, and the data and order information of TAMURA et al/ WINTER et al or is capable of this feature.

As for independent system³ claim 24, which has similar limitation as in independent system claim 1, part (a) and wherein part (b) has an electronic mail

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transmission means which transmits the combination of proof sheet and order information to the order user, the teaching of electronic mail transmission means for transmitting digital images and information is taught in TAMURA et al/WINTER et al, as shown in col. 1, lines 25-30, col. 6, lines 10-60, and col. 8, lines 25-55. Also, this is taught in Fig. 1A, col. 1.

Note above, item (5) Similarly, in claim 24, which has similar limitation in (a), it's interpreted for the same reason set forth in item (1) above.

6) Similarly, in claim 6, element (b), the phrase "which prints a voucher ... to the image printer", which has similar issue as item (2) of claim 1, it's interpreted for the same reason set forth in item (2) above.

No claims are allowed.

Response to Arguments

14. Applicant's arguments with respect to above claims on 7/17/08 have been considered but are moot in view of the new claim interpretations as shown on the "Notes (6)-(7)" with respect to claim interpretation/limitations/patentable weight above and new ground(s) of rejection which are caused by applicant's amendment of the claims.

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1. In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

2. Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday. Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805. The main FAX phone numbers for formal communications concerning this application are **(571) 273-8300**. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/

Primary Examiner, Art Unit 3689

7/5/09

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